IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Appl. No. | : | 10/083,064 | Confirmation No. | 4650 |
| Applicant | : | Kenneth James Aubuchon, et al. | | |
| Filed | : | 02/26/2002 | | |
| Title | : | METHOD AND SYSTEM FOR SEPARATING BUSINESS AND DEVICE LOGIC IN A COMPUTING NETWORK SYSTEM | | |
| Group Art Unit | : | 2614 | | |
| Examiner | : | Hemant Shantilal Patel | | |
| Docket No. | : | 1755/SPRI.90848 | | |
| Customer No. | : | 32423 | | |

**VIA EFS – January 29, 2009**

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA   22313-1450

<div align="center"><b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b></div>

As all claims in the above-noted Application have been at least twice rejected,

Applicant respectfully submits a Pre-Appeal Brief Request for Review along with a Notice of

Appeal and all proper fees by way of Deposit Account No. 21-0765.

**Is changing "computer device" to "computing device" the type of change that is not allowed at the after-final stage?**

The non-entry of amendments filed December 4, 2008 to overcome a 35 U.S.C. §

112 rejection is improper because the proposed amendments would have put the application in

better position for appeal and did not change the scope of the claims.

In the Final Action, claims 1 and 3-7 were rejected under 35 U.S.C. § 112, second

paragraph, as being indefinite.  The Office stated that independent claim 1 is indefinite because

"it is not clear if a communications component conveys something to the 'computer device logic'

or 'to the computer device.'  It is helpful to see what exactly happened.  By way of a 07/30/08

amendment, we requested that the third element (the one that matters here), be amended as to be

as follows (clean version):

> a communications component that conveys to the computer device
> logic to the computer device so that the computer device is able to
> implement the business requirement; and

This clearly had typos, which actually resulted in a 112 rejection. We want to

appeal issues regarding the substance of this clam, not the 112 rejection. Thus, to address the

112 issue, we most recently requested the following amendment:

> a communications component that conveys to the
> computercomputing device logic to the computercomputing device
> so that the computercomputing device is able to implement the
> business requirement; and

These claim amendments (made in a Response filed on December 4, 2008) are

the ones that was denied entry ostensibly because it would not put the case in better condition for

appeal and changed the scope of the claims. But surely changing "comput**er** device" to

"comput**ing** device" is not the type of amendment that would be prohibited even at the after-final

stage. This would help place the claim in better condition for appeal because it would remove

some simple typos, resolve the 112 issue, and enable the claim to be evaluated on the merits.

In an Advisory Action dated December 24, 2008, the Examiner refused to enter

the aforementioned amendments because the original claim supposedly conveyed *any*

*information* to the computing device, and that the amendment changes the claim so that only

*computing device logic* is conveyed to the computing device, thus narrowing the scope of the

claim. *Advisory Action of December 24, 2008, p. 2.* But it is clear that the only information ever

conveyed by the communications component is computing device logic. Furthermore, the

Applicants note that even if the amendment did limit the scope of the claim, the amendment

should have been entered because it removed issues for appeal and would have only required a

"cursory review by the examiner" because a claim of narrower scope would not have required a

new search. *MPEP 714.13.*

**The rejection of claims 1, 3-14 and 32 under 35 U.S.C. § 102(e) as being anticipated by Doleac should be withdrawn because Doleac does not disclose each and every element as set forth in the claims.**

Claims 1, 3-14 and 32 were rejected under 35 U.S.C. § 102(e) as being anticipated

by Doleac et al., U.S. Patent No. 6,668,053 ("Doleac"). A "claim is anticipated only if each and

every element as set forth in the claim is found, either expressly or inherently described, in a

single prior art reference" MPEP § 2131. Applicant respectfully submits that the rejection

clearly omits consideration of each and every element recited in the claim and that recited

features are not expressly or inherently described in *Doleac*. Our identical invention is not

disclosed in Doleac.

In a Response dated 7/30/08, we argued that Doleac does not disclose a system

for use in a network computer environment for implementing a business requirement, "wherein

the business requirement necessitates a change of at least one telecommunication service in a

geographic area, and wherein said change impacts a plurality subscribers associated with said

telecommunications network" as recited in independent claims 1 and 8.

In an Office Action Dated 10/30/08, the Office responded by citing Doleac,

column 1, lines 23-29. We understand that citations do not exclude other portions of the

reference. But, illustratively, in this citation, Doleac discloses applying a user priority level to

customer work order requests. These priority levels may be used in situations such as natural

disasters where the customer work orders correspond to restoring services for particular

subscribers such as a hospital or a police station *Id.* The Office cited a portion of this section of

Doleac out of context and implied that this is equivalent to this element of independent claims 1 and 8.

But this is not the case at least because Doleac specifically mentions "partial service restoration…such as restoring service a hospital or a police station prior to a resident." This further supports Applicants' arguments that the system disclosed by Doleac affects only one subscriber at a time. Therefore, the change does not impact an entire geographic area nor does it affect a plurality of subscribers. Thus, the Doleac reference is not directed to fulfilling business requirements relating to telecommunication services impacting a plurality of subscribers in an entire geographical area as recited in claims 1 and 8. For at least these reasons, claims 1 and 8 are allowable.

Similarly, independent claim 32 recites "a service interpreter component for receiving a plurality of data and a service identification, wherein said service identification corresponds to the task to be performed by the computing device, wherein said data is manipulated specifically for the computing device, wherein said service identification is used to identify the tables that need to be loaded with said data, and wherein said task relates to a change of at least one telecommunication service in a geographic area, wherein said change impacts a plurality of subscribers of said telecommunications network". Doleac discloses in column 3 lines 39-49 that a work order is to be translated into a specific service for a specific customer.

As discussed with respect to claims 1 and 8, the Office cited column 11, lines 23-29 of Doleac where applying a user priority level to customer work order requests is disclosed. As previously mentioned, these priority levels may be used in situations such as natural disasters where the customer work orders correspond to restoring services for particular subscribers such as a hospital or a police station.

Again, the Office cited this section of Doleac out of context and implied that this is equivalent to a task, "wherein said task relates to a change of at least one telecommunication service in a geographic area, and wherein said change impacts a plurality subscribers associated with said telecommunications network" as recited in independent claim 32.

As previously established, this is not the case at least because Doleac specifically mentions partially restoring services to a specific subscriber such as a hospital, not to a plurality of subscribers. Therefore, the task disclosed by Doleac is a task relating to a specific subscriber and not to the implementation or modification of telecommunication services in a geographic area impacting a plurality a subscribers as recited by claim 32. For at least this reason, claim 32 is allowable. Dependent claims 3-7 and 9-14 are allowable at least based on their dependency on allowable independent claims.

## CONCLUSION

For at least the reasons stated above, claims 1, 3-14, and 32 have been rejected based on clear error. Applicants respectfully request withdrawal of the pending rejections. If any issues remain that would prevent issuance of this application, the panel is urged to contact the undersigned – 816-474-6550 or jcamacho@shb.com (such communication via email is herein expressly granted) – to resolve the same.

Respectfully submitted,

/Jesse J. Camacho/
Reg. No. 51,258

SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO   64108-2613
816-474-6550